

Remarks

Applicant respectfully requests entry of the above amendment. This amendment deletes references to Appendix B in col. 1 and col. 90 that were proposed to be added in the reissue application. In addition, it deletes another reference to Appendix B at col. 94.

Applicant respectfully traverses the new matter rejection as set forth below. However, this rejection is moot in view of the fact that the references to Appendix B have been deleted, and Applicant no longer seeks entry of Appendix B into the specification.

Interview Summary

Applicant thanks Examiner Couso for conducting a telephone interview on November 1, 2005. The interview was hosted by Examiner Couso and included Examiner Couso's SPE, the SPRE responsible for this case, and Attorneys for Applicant, Joel Meyer and Steve Stewart.

In the Interview, the SPRE stated the general position that changes cannot be made to the specification of a patent as determined at the time of its issue date that would broaden the claims beyond the two year deadline for a broadening reissue. The SPRE generally raised a hypothetical in which addition of a new embodiment to the specification would cause the claims to cover a process that was not covered in the original patent.

Attorney for Applicant pointed out that the Office's rejection had not identified how the proposed re-insertion of the Appendix B source code would specifically broaden any claim in U.S. Patent 5,862,260 (the '260 patent). As such, there is an insufficient record upon which to formulate a response.

The final Office Action was confusing because it focused on alleged differences between the proposed amendments and the original application. In particular, the Office Action indicated in section 4 that "the examiner would have no problem entering the same exact Appendix as found in the original application." Based on this representation, Applicant had demonstrated through a declaration and references to the original application that Appendix B and the amendments consisted of the same material as the original application.

In the Interview, the SPRE clarified that the Office's concern was not new matter relative to the original application, but rather, it was concerned with a potential broadening of the claims, which is to be evaluated relative to the patent as issued, not relative to the original application.

In view of the foregoing, the Office representatives indicated that they would vacate the rejection and issue a new action identifying how the patent claims had been broadened, if at all.

While the issue of broadening the claims is now moot in view of the amendments submitted herewith, Applicant makes the following comments regarding the rejection in section 2 of the final Office Action. The section 2 of the final rejection indicated that the prior amendments to cols. 1 and 90 made the claims broader in scope. It is unclear how the mere references to the source code listing could broaden any of the claims. The amendment to col. 90 refers to the source code listing as representing a steganographic marking/decoding “plug-in” for use with Adobe Photoshop software. The specification of the ‘260 patent refers to the incorporation of steganographic software in Adobe products a number of times. See, for example, col. 23, lines 7-15, and col. 90, lines 62-66. Thus, the mere fact that the proposed amendment refers to a plug-in within Adobe Photoshop software does cause a broadening of the claims. This issue is now moot since the proposed amendments to cols. 1 and 90 have been removed.

The possibility that Appendix B includes other material that does not constitute an embodiment of any claim in the ‘260 patent is not relevant to the new matter issue because such other material, to the extent it exists, cannot broaden the claim if it does not relate to or support the claim language. Nevertheless, this issue is moot since Applicant has withdrawn its amendment to re-insert Appendix B source code as an Appendix of the patent.

Submission of U.S. Patent 5,862,260

Pursuant to 37 C.F.R. Section 1.178, Applicant has submitted herewith original U.S. Patent 5,862,260. The reissue application should now be passed to issuance.

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Respectfully submitted,

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